

ESTTA Tracking number: **ESTTA493579**

Filing date: **09/10/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	The Three Sons Inc.
Granted to Date of previous extension	09/29/2012
Address	902 10th Street Milford, IA 51351-1530 UNITED STATES
Attorney information	Edmund J. Sease McKee, Voorhees & Sease, P.L.C. 801 Grand Avenue, Suite 3200 Des Moines, IA 50309 UNITED STATES mvslit@ipmvs.com Phone:515-288-3667

### Applicant Information

Application No	85553670	Publication date	07/31/2012
Opposition Filing Date	09/10/2012	Opposition Period Ends	09/29/2012
Applicants	Kielman, Christopher Charles 2418 Adams Avenue Spirit Lake, IA 51360 UNITED STATES  Kielman, Jennifer Lynn 2418 Adams Avenue Spirit Lake, IA 51360 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: shirts, pants and shoes
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1110576	Application Date	05/12/1977
Registration Date	01/02/1979	Foreign Priority Date	NONE

Word Mark	UNIVERSITY OF OKOBOJI
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1975/06/00 First Use In Commerce: 1975/06/00 COLLEGIATE-TYPE CLOTHING-NAMELY, FOOTBALL JERSEYS, ATHLETIC TYPE T-SHIRTS, SWEAT SHIRTS, JOGGING SUITS, JOGGING SHORTS, AND JACKETS

Attachments	Notice of Opposition.pdf ( 8 pages )(1101150 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Edmund J. Sease/
Name	Edmund J. Sease
Date	09/10/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>THE THREE SONS, INC.,</p> <p style="text-align: center;">Opposer,</p> <p>v.</p> <p>CHRISTOPHER CHARLES KIELMAN, and JENNIFER LYNN KIELMAN,</p> <p style="text-align: center;">Applicants.</p>	<p>Opposition No: _____</p> <p>In the matter of: Application No: 85/553,670 Mark: OKOBOJI STATE Published in Official Gazette on: July 31, 2012</p>
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**NOTICE OF OPPOSITION**

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

The Three Sons, Inc. ("Opposer"), an Iowa corporation with its principal place of business at 902 10th Street, Milford, Iowa 51351, believes that it will be damaged by registration of the trademark OKOBOJI STATE in Application Serial No. 85/553,670 filed February 27, 2012 by Christopher Charles Kielman and Jennifer Lynn Kielman ("Applicants"), and hereby opposes registration of the mark. The grounds for opposition are as follows:

1. Application Serial No. 85/553,670 was published for opposition on July 31, 2012. Opposer was granted a 30-day extension of time to oppose the application on August 17, 2012. This Notice of Opposition is timely filed.
2. Applicants seek to register the mark OKOBOJI STATE in connection with shirts, pants and shoes in International Class 025.

3. Opposer owns U.S. Registration No. 1,110,576 for the mark UNIVERSITY OF OKOBOJI, filed on May 12, 1977 and registered on January 2, 1979, for use in connection with "Collegiate type clothing namely, football jerseys, athletic type T-shirts, sweatshirts, jogging suits, and jackets" in Class 025. A true and correct copy of the registration is attached hereto as Exhibit A.

4. Opposer's Registration No. 1,110,576 for its UNIVERSITY OF OKOBOJI mark has not been cancelled, is valid and in full force and effect and is incontestable.

5. As a result of considerable time and effort invested in advertising and marketing the goods and services offered under Opposer's UNIVERSITY OF OKOBOJI mark, the mark has enjoyed substantial recognition in the marketplace, has secondary meaning, and represents valuable goodwill inuring to the benefit of Opposer.

6. Opposer has previously litigated the UNIVERSITY OF OKOBOJI mark against use of OKOBOJI STATE UNIVERSITY in the Southern District of Iowa, 24 U.S.P.Q.2d 1075 (S.D. Iowa 1992) and prevailed on the grounds of likelihood of confusion. A true and accurate copy of the decision is attached hereto as Exhibit B.

7. Opposer has priority over Applicant with respect to the mark at issue.

8. Applicant's OKOBOJI STATE mark is confusingly similar to Opposer's previously used and registered UNIVERSITY OF OKOBOJI mark as the marks themselves are nearly identical and the goods are related, and are of the type to be promoted in the same channels of trade to the same consumers or class of consumers in the same trade area.

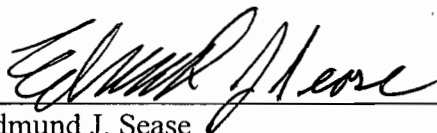
8. Due to the similarity between the respective marks and the respective goods, consumers are likely to believe that Applicants' goods originate from Opposer or are otherwise

endorsed, sponsored or approved by Opposer, resulting in a likelihood of confusion in the marketplace and damage to Opposer.

9. Applicants do not have Opposer's consent to use or register Applicants' mark.

WHEREFORE, Opposer requests that this opposition be sustained and the registration sought by Applicants be refused.

Respectfully submitted,

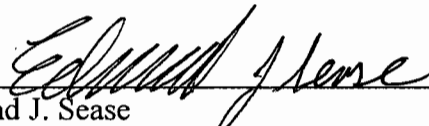
A handwritten signature in cursive script, appearing to read "Edmund J. Sease", is written over a horizontal line.

Edmund J. Sease  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, IA 50309-2721  
Phone: 515-288-3667  
Fax: 515-288-1338  
Email: mvslit@ipmvs.com

*ATTORNEYS FOR OPPOSER*

**CERTIFICATE OF FILING**

I hereby declare that the attached **NOTICE OF OPPOSITION** has been filed via the Electronic System for Trademark Trials and Appeals (ESTTA) this 10 day of Sept, 2012.

  
\_\_\_\_\_  
Edmund J. Sease

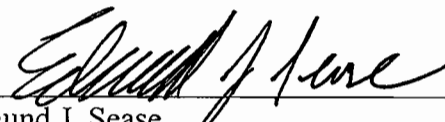
**CERTIFICATE OF SERVICE**

I hereby declare that the foregoing document was served upon the following at the correspondence address of record on the USPTO TARR system, this 10 day of Sept, 2012, via:

X      1<sup>st</sup> Class U.S. Mail  
☐      Facsimile  
☐      Other \_\_\_\_\_

☒      Federal Express  
☐      Hand Delivery

Christopher Charles Kielman  
2418 Adams Avenue  
Spirit Lake, IA 51360

  
\_\_\_\_\_  
Edmund J. Sease

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,110,576  
Registered Jan. 2, 1979

**TRADEMARK**  
Principal Register

**UNIVERSITY OF OKOBOJI**

The Three Sons, Inc. (Iowa corporation)  
Milford, Iowa 51351

For: COLLEGIATE-TYPE CLOTHING—NAMELY,  
FOOTBALL JERSEYS, ATHLETIC TYPE T-SHIRTS,  
SWEAT SHIRTS, JOGGING SUITS, JOGGING  
SHORTS, AND JACKETS—in CLASS 25 (U.S. CL. 39).  
First use June 1975; in commerce June 1975.

Ser. No. 126,459, filed May 12, 1977.

PAUL F. GAST, Examiner

**EXHIBIT A**

Decided June 26, 1992

3741, 3762 [19 USPQ2d 1472] (N.D. Ill. 1991). It would be grossly unfair to allow the defendant to produce certain selected documents which it feels support its defense while withholding from the plaintiff possibly damaging communications which tend to disprove the defendant's theory. *Board of Trustees v. Coulter Corp.*, 118 F.R.D. 532 [4 USPQ2d 1652] (S.D. Fla. 1987); *Abbott Laboratories*, 676 F. Supp. at 832; *Macrovision Corp. v. VSA Limited*, 12 U.S.P.Q.2d 2011 (D. Or. 1989).

[1] Here, Nissei has apparently chosen to rely upon the advice of counsel as a defense to the charge of willful infringement. If Nissei intends to rely, at trial, upon this defense, the law is clear: Nissei must produce to FMT not only the opinions upon which Nissei has chosen to rely, but also all other attorney communications on the same subject matter and all documents relied upon or considered by counsel at the time and in conjunction with rendering that opinion. *Columbia Cascade Co. v. Interplay Design, Ltd.*, 17 U.S.P.Q.2d 1882 (D. Or. 1990); *Macrovision Corp. v. VSA Ltd.*, 12 U.S.P.Q.2d 2011 (D. Or. 1989); *Abbott Laboratories*, 676 F. Supp. at 832; *Baxter Travenol Laboratories, Inc. v. Abbott Laboratories*, 1987 U.S. Dist. LEXIS 10324 (N.D. Ill. 1987).

In the context presented by the defendant, the court declines to examine Nissei's allegedly privileged documents *in camera*. Moreover, the court will not consider the issue of willfulness without allowing FMT to examine and respond to the opinions and documents relied upon by Nissei. Accordingly, the defendants' motion in limine [Docket Item No. 153] is DENIED.

#### Summary

- (1) The defendant Nissei ASB Company's ("Nissei") motion for summary judgment [Docket Item No. 154] is hereby DENIED;
  - (2) Nissei's motion in limine [Docket Item No. 153] is hereby DENIED; and
  - (3) The plaintiff FMT Corporation, Inc.'s ("FMT") motion under Rule 56(f) [Docket Item No. 158] is hereby GRANTED.
- SO ORDERED.

District Court, S.D. Iowa

The Three Sons Inc. v. Okoboji State University Ltd.

No. 4-92-CV-80310

#### REMEDIES

##### 1. Non-monetary and injunctive — Equitable relief — Preliminary injunctions — Trademarks and unfair trade practices (§505.0707.09)

Defendant's use of "Okoboji State University," on t-shirts used to raise money for charitable projects, is likely to create confusion with plaintiff's registered and common law marks "University of Okoboji" and "Okoboji University," which also appear on t-shirts and for funding of charitable projects, and thus warrants preliminary injunction prohibiting defendant from using words "Okoboji" and "University" in sale of clothing and solicitation of charitable contributions.

Action by The Three Sons Inc. against Okoboji State University Ltd., Jeffrey T.A. Christenson, and Craig Crawford, for trademark infringement. On plaintiff's motion for preliminary injunction. Motion granted.

Edmund J. Sease, of Zarley, McKee, Thomte, Voorhees & Sease, Des Moines, Iowa, for plaintiff.

Kent A. Herink, of Davis, Hockenberg, Wine, Brown, Koehn & Shors, Des Moines; Robert Sackett, of Sackett & Howe, Spencer, Iowa, for defendants.

Wolle, C.J.

The court held an evidentiary hearing on the plaintiff's resisted request for preliminary injunction in this trademark infringement action, receiving opening statements, evidence, and closing arguments on Tuesday, June 23, and Thursday, June 25, 1992. Thereafter, the court announced its preliminary decision and allowed the parties until the morning of June 26, 1992, to provide further briefs resisting the wording of the proposed decision. The following constitute the final findings of fact, conclusions of law, and preliminary injunctive decree; this written decision supersedes the court's previous oral ruling and shall become effective at 10:00 a.m. on Friday, June 26, 1992.

#### FINDINGS OF FACT

1. Plaintiff is an Iowa corporation, with its principal place of business at Milford, Iowa; defendant, Okoboji State University, Ltd., is an Iowa corporation, incorporated on May 4,

EXHIBIT B

1992; defendant, Jeffrey T. A. Christenson, is a resident of Spirit Lake, Iowa, and is the president of the defendant corporation; defendant, Craig Crawford, is secretary and director of the corporate defendant, and is a permanent resident of Wauke, Iowa 50263 within this District.

2. Plaintiff is the owner of United States federal trademark registration number 1,110,576 for the word mark University of Okoboji, and for federal trademark registration number 1,112,338 for the University of Okoboji seal.

3. Since 1985 plaintiff has used as a common-law trademark, Okoboji University, on shirts it has been selling; plaintiff has used its marks continuously since 1975 and has sold a high volume of clothing bearing these trademarks.

4. Plaintiff's marks have a secondary meaning in the Iowa Great Lakes Region, in that many people associate "The Campus" in the area with the mythical University of Okoboji and associate plaintiff's business operations with the words "Okoboji" and "University" when used in combination.

5. Defendants have been selling T-shirts bearing the mark "Okoboji State University" with a circular crest and the words "The Wave" associated with the crest; they began the sale of these shirts in late May 1992.

6. Defendants' shirts are intended for sale in plaintiff's trade area to the same customers who are targets of plaintiff's clothing business; buyers of T-shirts tend to be impulse buyers rather than discriminating purchasers who would examine the product with care.

7. Salient features of the defendants' mark, as depicted on defendants' shirts offered for sale, are "Okoboji" and "University," coupled with a large circular emblem.

8. Plaintiff has permissibly allowed the University of Okoboji Foundation to use its mark and its seal; this foundation has solicited the public for contributions toward funding of charitable projects that benefit persons living permanently or vacationing in the Iowa Great Lakes region.

9. Defendants have used the name "Okoboji State University Trust" in raising money from the public for their own charitable projects.

10. Defendants' pattern of doing business bears a striking similarity to plaintiff's business, particularly with respect to the similarity of their marks and the similarity of their customer bases and trade area. Defendants' conduct in using the names "Okoboji State University" or variations of that basic name is likely to create confusion and lead plaintiff's customers to believe erroneously that

there is an association or sponsorship of the defendants' business and charitable activities by the plaintiff.

11. Plaintiff's remedy at law is not adequate; the defendant corporation is lightly capitalized; damages would be difficult to prove; and if a preliminary injunction does not now issue, the plaintiff's credibility in the marketplace and use of its marks in connection with its business and associated foundation could be severely harmed.

12. Defendants are gainfully employed in other full-time occupations; they have undertaken the use of a variation of "Okoboji" and "University" fully recognizing the risk of this challenge by plaintiff and its costs to their proposed enterprises.

13. The public interest is served by providing customers a clear and distinct identification of the source of products and identity of persons soliciting funds for charitable purposes; while the public interest is served by vigorous competition, defendants can compete with the plaintiff by using a name which is distinct and distinguishable from the plaintiff's; defendants may continue selling shirts and promoting the Dial-A-Ride program so long as they do not use plaintiff's marks or colorable variations of them.

14. A bond in the amount of \$50,000 posted by plaintiff to protect defendants will be sufficient to protect defendants in the event this preliminary injunction is improvidently issued and causes them harm.

#### CONCLUSIONS OF LAW

1. The court has jurisdiction of the parties and subject matter of this case based on the United States trademark laws. See 28 U.S.C. §1338(a).

2. Plaintiff has shown persuasively a likelihood of consumer confusion if defendants continue to use the name Okoboji State University or variations containing the words "Okoboji" and "University" in connection with promoting charitable activities or advertising and selling clothing, such as the T-shirts in evidence in this case. *Black Hills Jewelry Mfg. Co. v. Gold Rush, Inc.*, 633 F.2d 746, 753 [208 USPQ 631] (8th Cir. 1980); *Squirt Co. v. Seven-Up Co.*, 628 F.2d 1086, 1091 [207 USPQ 897] (8th Cir. 1980).

3. Plaintiff owns federal trademark registration number 1,110,576 for the University of Okoboji word mark, and federal trademark registration number 1,112,338 for the University of Okoboji seal, and those marks are incontestible, since Section 8 and 15 affidavits have been filed. See 15 U.S.C. §§1065, 1115.

[1] 4. Plaintiff has satisfied all factors set forth in *Dataphase Sys. Inc. v. C.L. Sys., Inc.*, 640 F.2d 109 (8th Cir. 1981), and in *Dakota Indus., Inc. v. Ever Best Ltd.*, 944 F.2d 438, 440 [20 USPQ2d 1158] (8th Cir. 1991). Plaintiff's evidence of trademark validity, knowing infringement of the trademark, confusion, competitive products' proximity, and irreparable harm is persuasive. Damages at law would be difficult to prove and inadequate should plaintiff ultimately prevail on the merits. On balance, the harm to plaintiff outweighs the potential of harm to defendants. The public interest would be served by injunctive relief because the public may be confused by the defendants' use of the name Okoboji State University, or similar variations of the words "Okoboji" and "University" in the sale of clothing and solicitation of charitable contributions to worthwhile projects.

5. The court will not in this preliminary decree attempt to define explicitly what alternative names, marks, or actions defendants might take to avoid infringing plaintiff's marks and rights; defendants may during the course of trial preparation and at trial request modification of this decree by written application and notice to plaintiff.

6. Defendants are entitled to require plaintiff to post a \$50,000 bond, cash or equivalent, approved by the clerk of this court, before obtaining injunctive relief.

IT IS THEREFORE ORDERED, ADJUDGED, AND DECREED:

These three defendants, and no other persons, are hereby enjoined from:

A. Making any use of the names University of Okoboji, Okoboji University, or Okoboji State University, or colorable variations in connection with any promotions, charitable or otherwise, or solicitation for funds from members of the public; and

B. Making any use of the names University of Okoboji, Okoboji University, or Okoboji State University, or colorable variations in connection with the advertising or sale of clothing; and

C. Otherwise infringing plaintiff's federal registered marks 1,110,576 and 1,112,338; and

D. The plaintiff will be entitled to injunctive relief upon filing a bond, cash or equivalent, in the amount of \$50,000. The bond would have to be approved by the clerk of court and would have to be filed with the clerk of court; that to protect the defendants in the event the injunctive relief granted results in harm and in the event the plaintiff

does not prevail on the merits at the conclusion of the case.

IT IS SO ORDERED.

District Court, S.D. Ohio

Champion International Inc. v. Technology Development Corp.

No. C-2-92-0001

Decided June 30, 1992

#### JUDICIAL PRACTICE AND PROCEDURE

1. Jurisdiction — Subject matter jurisdiction — Case or controversy (§405.0703)

#### REMEDIES

Non-monetary and injunctive — Declaratory judgments (§505.05)

Defendant, in action for declaratory judgment of patent invalidity and non-infringement, has created reasonable apprehension that it will initiate patent infringement action against plaintiff, since inventor/assignor of patent in suit, in Petition to Make Special filed with Patent and Trademark Office, alleged that patent is being infringed by plaintiff, and since inventor previously filed state court action against plaintiff alleging misappropriation of trade secret.

Action by Champion International Inc. against Technology Development Corp. for declaration of patent invalidity, unenforceability, and non-infringement. On defendant's motion to dismiss. Motion denied.

John E. Kidd, Leora Ben-Ami, and Peter S. Canelias, of Shea & Gould, New York, N.Y.; Michael K. Yarbrough, of Frost & Jacobs, Columbus, Ohio, for plaintiff.

Patrick P. Phillips, of Biebel & French, Columbus, for defendant.

Kinneary, J.

This matter comes before the Court to consider the motion of the Defendant, Technology Development Corp., to dismiss the Complaint. Fed. R. Civ. P. 12. Essentially, the question before the Court is whether the instant action satisfies the "case or controversy" requirement found in Article III of the United States Constitution. As with all motions to dismiss, the facts alleged in the Complaint must be taken as true for the purpose of deciding the motion. *Goodrich-Gulf Chemicals, Inc. v. Phillips Petroleum*